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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/757,266	January 14, 2004
		First Named Inventor	
		Koutlakis	
		Art Unit	Examiner
		1755	Marcheschi
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 36,360 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>Signature: <u>Mark R. Leslie</u> Typed or printed name: <u>Mark R. Leslie</u> Telephone number: <u>(412) 355-6271</u> Date: <u>November 22, 2006</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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November 22, 2006



Attorney Docket No.
030901/SI.029.US01
Pittsburgh, Pennsylvania 15222

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 1755
In re application of Koutlakis, *et al.*
GLASS-LIKE POLYSACCHARIDES
Serial No.: 10/757,266
Filed: January 14, 2004
Examiner: Michael A. Marcheschi

Mailstop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Arguments and Remarks for Pre-Appeal Brief Conference

Sir:

In response to the Final Office Action of October 12, 2006 in the above identified application, Applicants request a Pre-Appeal Brief Conference in accordance with the guidelines in the "New Pre-Appeal Brief Conference Pilot Program" announcement, which appeared in the July 12, 2005 issue of the *Official Gazette*. In accordance with those guidelines, comments for the conference are presented herein. Filed concurrently herewith are a Pre-Appeal Brief Request for Review (form PTO/SB/33), a Notice of Appeal, a reprint of *In Re Van Mater* cited by the Examiner, and the fee under 37 C.F.R. § 41.20(b)(1). Also filed are a Petition for Extension of Time and the appropriate fee. Any deficiency or overpayment may be charged or credited, respectively, to Deposit Account No. 11-1110.

The issues addressed herein are ripe for appeal in accordance with 37 C.F.R. § 41.31(a)(1), the claims having been subject to at least two rejections.

Arguments

Applicants filed a Response After Final, including proposed amendments, on September 22, 2006, which resulted in the Advisory Action mailed October 12, 2006. The Advisory Action indicated that the rejections under 35 U.S.C. § 103(a) were maintained for reasons previously of record. Applicants request withdrawal of the following rejections: 1) the rejection of claims 15-32 under 35 U.S.C. § 103(a) as assertedly being obvious over Koutlakis *et al.* in view of Rosenflanz and Blanton *et al.*; 2) the rejection of claims 15, 17, 18, 20, 22, 24, and 26-27 under 35 U.S.C. § 103(a) as assertedly being obvious over Lane *et al.* in view of Rosenflanz and Blanton *et al.*; and 3) the

rejection of claims 16, 19, 21, 23, 25, 24, and 27-32 under 35 U.S.C. § 103(a) as assertedly being obvious over Koutlakis *et al.* in view of Rosenflanz and Blanton *et al.* Applicants submit that a *prima facie* case of obviousness cannot be established for any of claims 15-32 for, *inter alia*, the following reasons: no suggestion or motivation exists to modify or combine the teachings of the references; the references teach away from the combination of the references; and the case of *In re Van Mater* does not state that “a reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments” as asserted by the Patent Office, which has led to the improper establishment of obviousness by the Patent Office.

Obviousness Rejections

Claims 15-32 have been rejected under 35 U.S.C. § 103(a) as assertedly being obvious over Koutlakis *et al.* in view of Rosenflanz and Blanton *et al.* Applicants submit that a *prima facie* case of obviousness cannot be established since no suggestion or motivation exists to modify or combine the teachings of the cited references and that the cited references, even if combined, do not teach or suggest each and every element of any of claims 15-32. If anything, the Koutlakis *et al.* patent teaches away from the combination of the cited references to arrive at the claims of 15-32.

The key issues in the present appeal are: whether the Patent Office has provided a suggestion or motivation to combine the cited references; whether the Patent Office is giving the Koutlakis Declaration its proper evidentiary weight; and whether substantial evidence exists on the record to establish or not establish obviousness.

The Applicants respectfully submit that the statements in the Final Office Action used to modify and/or interpret the cited references in an attempt to form a *prima facie* case of obviousness are **unsupported assumptions** which are disputed by the evidence of record (i.e., the Declaration by Koutlakis). In establishing a *prima facie* case of obviousness, it must be determined whether substantial evidence exists to establish obviousness since the Federal Circuit has stated that the ultimate determination of obviousness is subject to the substantial evidence standard. (*See, In re Kotzab*, 217 F3d 1365, 1369, 55 USPQ2d 1313 (Fed. Cir. 2000)). “In reviewing the record for substantial evidence, we must take into account evidence that both justifies and detracts from the factual determination.” (*Id.*) The Federal Circuit further indicated that whether the Patent Office relies on express or inherent showings for obviousness, “broad conclusory statements standing alone

are not ‘evidence.’” (*Id.* at 1370). “Rather, the [Patent Office] must point to some concrete evidence in the record in support of these findings.” (*See, In re Zurko, supra*).

The Applicants respectfully submit that when the evidence of the record is reviewed, the Declaration of Koutlakis clearly establishes that the blasting medium of Koutlakis *et al.* and Lane *et al.* could not be used as an agitating medium. (See, Declaration of Koutlakis, page 3). This substantial evidence of record supports the conclusion that obviousness cannot be established, as opposed to the unsupported assumptions of the Final Office Action.

Instead of finding concrete evidence to support its teaching or suggestion to combine the cited references, The Office Actions cite case law which is purported to state that “A reference can be used for all it realistically teaches and is not (sic) limited to the disclosure in its preferred embodiments (i.e., examples).” *See*, Advisory Action mailed October 12, 2006, page 2, citing *In re Van Ma[r]ter* (sic). Applicants have read the cited case, but such statement is not present. *In re Van Mater* (submitted herewith) states that “a reference is good... for what it suggests to a person of skill in the art.” *In re Van Mater* 144 U.S.P.Q 421, 243 (CCPA, 1965). Thus, if anything, the law in *In re Van Mater* supports the Applicants’ position that one of ordinary skill in the art (as evidenced by the Koutlakis declaration) would conclude that the polysaccharides of the Koutlakis *et al.* patent are not suitable for use as an agitation media.

In formulating the obviousness rejection, the Examiner asserts that because polysaccharides are a “grit” and are “abrasive,” one of skill in the art would be motivated to adapt such particles for use in agitating applications. *See*, Advisory Action mailed October 12, 2006, page 4. However, the terms “grit” and “abrasive” do not guide one of skill in the art to any particular application. Rather, these terms are generic descriptions of hard particles. The Declaration of Koutlakis was submitted in support of this fact, stating that “blasting media and agitating media are not generally equivalent or even scalable, and the size of an agitating medium is only one of multiple variables that must be considered along with hardness, the shape of the medium, and a variety of other factors.” *See*, Declaration of Koutlakis mailed April 24, 2006. As further stated in the Declaration of Koutlakis, “the blasting medium described in Koutlakis *et al.* or Lane *et al.* could not be used as an agitating medium.” *Id.* However, these statements were dismissed as “opinion” evidence. *See*, the Office Action mailed November 23, 2005. As stated by the Federal Circuit, “with respect to core factual

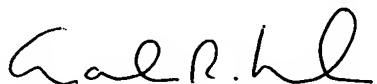
findings in a determination of patentability... the [Patent Office] must point to some concrete evidence in the record in support of these findings,” which the Patent Office has not done. (*In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001)).

The remaining rejections of the claims are also in error for the same reasons discussed above and made of record. First, as argued in the Office Action Response mailed on September 22, 2006, the rejection of claims 15, 17, 18, 20, 22, 24, 26-27, and 47 as being obvious over Lane *et al.* in view of Rosenflanz and Blanton *et al.* is overcome as there is no teaching or guidance as to how to modify the references to adapt blasting media to reach the compositions as claimed. Secondly, the rejection of claims 16, 19, 21, 23, 25, 27-32, and 48-49 as being assertedly obvious over Lane *et al.*, in view of Koutlakis *et al.*, Rosenflanz, and Blanton *et al.* is overcome because there is no teaching or guidance as to how to adapt blasting media into agitating media. In both instances, there is a complete lack of disclosure of the polysaccharides disclosed in Lane *et al.* as being suitable for agitating media. Moreover, the large size of particles that is currently claimed is not disclosed. Although particles within this size range are disclosed in other references, there is no guidance as to how to adapt the polysaccharide particles disclosed in Lane *et al.* to be suitable as agitating media. Finally, the Declaration of Koutlakis overcomes any *prima facie* case as these references are specifically addressed along with Koutlakis *et al.* Thus, the previous Office Actions have failed to make a *prima facie* case, and, to the extent one could even be made, the Declaration of Koutlakis would overcome it.

CONCLUSION

Applicants submit that claims 18-52 are in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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ship and registration of a number of marks containing this prefix is not sufficient to create that exclusivity claimed for the prefix "pola," per se, under the theory advanced.

[2] We are familiar with the prior decisions cited by appellant. As has been often said by this court, prior decisions in trademark cases, where the issue is a likelihood of confusion, furnish meager assistance in the resolution of that issue. Each case must be decided on the basis of the factual situation thereby presented.

Finding no reversible error in the decision of the board, we must therefore affirm.

52 CCPA 1076

Court of Customs and Patent Appeals

In re VAN MATER AND CAMPBELL

Appl. No. 7256. Decided Feb. 11, 1965

Rehearing denied Apr. 8, 1965

PATENTS

1. Patentability—Anticipation — Patents —In general (§ 51.2211)

Patent is good reference not only for what it discloses by way of direct anticipation but also for what it suggests to person of ordinary skill in the art.

Particular patents—Saw

Van Mater and Campbell, Manufacture of Metal Band Saws and the Like Including Blanks and Alloys Therefor, claims 27 and 39 of application refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Laurance F. Van Mater and Kenneth E. Campbell, Serial No. 622,169, filed Nov. 14, 1956; Patent Office Group 110. From decision rejecting claims 27 and 39, applicants appeal. Affirmed.

ROWLAND V. PATRICK, Boston, Mass., for appellants.

CLARENCE W. MOORE (S. WM. COCHRAN of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

RICH, Judge.

This appeal is from the divided decision of the Patent Office Board of Appeals affirming the rejection of

claims 27 and 39 in application serial No. 622,169, filed November 14, 1956, for "Manufacture of Metal Band Saws and the Like Including Blanks and Alloys Therefor." No claims stand allowed, but the examiner's rejection of method claim 40 was reversed by the board.

The invention relates to a bandsaw or hacksaw blade and to the method of making same, herein referred to simply as the "saw." The saw has two principal zones or regions, a cutting edge composed of high-speed tool steel and a backing zone composed of a steel of the same composition as high-speed tool steel except for substantially lesser amounts of carbon. This differential composition of the cutting edge and of the backing zone allows the attainment of a fully hardened cutting edge and a tough, unhardened backing zone even though a uniform heat treatment and quenching of the whole saw blade strip is carried out because the carbon content of the backing zone is sufficiently less than that of the cutting edge so as not to be hardened to a state of brittleness.

Appellants obtain the differential composition of the strip from which their saw is to be made by starting with a steel strip having a homogeneous composition identical to high-speed tool steel except for having a lesser amount of carbon. They then transform only the cutting edge of the strip into high-speed tool steel by selective carburization. The teeth are cut and the entire strip is finally heat treated and quenched, thereby obtaining a differential hardness between the two zones.

Claim 27 reads as follows:

27. A metal band saw, hack saw or the like comprising an integral strip structure of low-carbon carburizing grade high speed tool steel of calculated reduced carbon content in the melt as contrasted with standard high-speed tool steels including a cutting-edge working zone of full hardness of the order 64 to 66 Rockwell C and a backing zone of less than file hardness and as represented by an average hardness value of about 45 Rockwell C, wherein the working zone is defined by a preferentially carburized longitudinal edge portion of the strip and with the carbon contents of said zones so mutually correlated and controlled as to initial content in the melt and as to carburizing solely of the working zone that said final hardnesses are had in a single one-temperature high heat treating operation common to the entirety of the structure, and wherein

the less-hard backing zone contains the roots and gullet bottoms of the saw teeth.

The references relied upon by the examiner are:

Neill 907,167 Dec. 22, 1908

Strauss 1,537,381 May 12, 1925

Tool Steels, pages 494 to 501, edited by Gill. Published in 1944 by the American Society for Metals.

The sole issue before us is the propriety of a rejection predicated on 35 U.S.C. 103, the examiner and board having found the appealed claims to be unpatentable over Neill in view of Strauss and Gill.

Neill discloses a method of producing saws with a high carbon cutting edge and a low carbon backing which can be heat treated in one operation to obtain a saw blade of greater durability and reliability. He obtains the desired difference in carbon content between cutting edge and backing by casting an ingot of two steels, one of which is cast upon the other, the two steels being integrally welded together and remaining so throughout subsequent operations. The material is rolled to gauge and the strip is slit to obtain the blade. The teeth are cut along one edge and the blade is then heat treated in a single operation to obtain a saw blade having a hardened working edge with a tough and durable backing. The patentee says:

By the use of this process a much higher carbon steel may be provided for the edge of the saw than could safely be used where the steel is of the same carbon content throughout * * *.

Strauss discloses a method for producing a cutting or milling tool broadly by selecting a material of low carbon content and then "cementing" (hereinafter called carburizing since it is admitted by appellants that the two terms mean the same in this art) the cutting edge and finally uniformly heating and quenching the steel to obtain a hardened cutting edge and a backing which is tough and ductile. This reference is the United States counterpart of an application filed in Germany on March 28, 1919, and portions of the translated version are somewhat ambiguous. Since an understanding of this reference is essential to deciding the issue presented, the pertinent portion thereof is set out below:

The method consists in making the said tools of an alloy of iron—not capable of being hardened per se—comprising from 0.1 to 0.2% of carbon

and 8 to 14% of chromium, then cementing them at the cutting edge in the customary manner, and finally subjecting the tools so made to the usual tempering process by first heating and then quenching them.

(It has been found expedient to add nickel to the alloy in a proportion of from 0.2 to 2%).

In the case of tools manufactured in accordance with the above-described method, it is only the cemented cutting edge which becomes glass-hardened whereas the adjoining layers of the steel obtain a gradually decreasing degree of hardness and great toughness, with the result that the cutting edge will be rendered specially capable of taking up the shocks created when working, without breaking off or snapping. This advantage will particularly also then be achieved on the entire tool being uniformly heated and then quenched as an entirety. The improved method is therefore specially suitable for such kinds of tools which, as, for example, milling cutters and face and side cutters, can only be hardened by being uniformly heated and thereupon quenched as entirety. For, in this case, tools of this type if made of common tool steel or of high speed tool steel, would not only become glass-hardened at the cutting edges but in an objectionable manner all over.

The Gill publication (textbook) discloses, in a section entitled "Effect of Alloying Elements in High Speed Steel," that a lowering of carbon content produces a tool steel which is more ductile and tough than steels of higher carbon content. Gill discloses that high speed steel can be carburized and that such carburized part is of higher hardness upon quenching than the uncarburized part, which is relatively soft.

The position of the examiner, affirmed by the board, was that the secondary references show that cutting tools in general are made of high-speed tool steel when a durable cutting edge is desired and, that being true, the selection of high-speed tool steel for the cutting edge of the Neill saw, i.e., a saw having a hardened working edge and a tough and durable backing, would be an obvious application of the known hardening properties of this steel. The board also said:

We further share the view of the examiner that one wishing to make the Neill sawteeth of modern high speed tool steel would be directed by the Strauss patent to fabricate the saw first of a homogeneous material

of a composition equal to the composition of the ultimate cutting edge, high speed tool steel, less sufficient carbon so as to make the steel not hardenable to the degree that it would become brittle on an overall hardening treatment and to thereafter raise the carbon content of the cutting surfaces only by selective carburizing. [Our emphasis.]

In regard to the last paragraph of the Strauss disclosure quoted above, the board said:

We do not consider the Strauss process to be applicable only to the particular tool steel alloys specified in the patent but is a procedure generally applicable to any steel in which the hardenability is a function of the carbon content and is capable of selective carburization. These characteristics of high speed tool steel are well known as is evident by the Gill publication.

The fact that Strauss describes * * * an overall hardening characteristic of tools made wholly of high speed tool steels that are uniformly heated and quenched does not indicate to us any inapplicability of his disclosed process either to other tool steels than the one disclosed or to high speed tool steels in particular. Instead we gather that these undesired hardening characteristics would be found not because of the steel used but because the tool is made entirely of the same highly hardenable material and because uniform hardening of the whole tool is practiced.

According to appellants, their main quarrel with the decision of the majority of the board was the conclusion that one would be directed by Strauss to carburize only the tooth edge portion of a high-speed tool steel having an initially deficient carbon content and which was prepared from a homogeneous material. It is appellants view that—

* * * Strauss directs one to use his cementing only in tools made with a material *which is not hardenable* per se in order to accomplish a result that cannot be accomplished with hardenable high speed tool steel.

We do not understand the Strauss disclosure to be so restricted. The patent says that the improved method is *especially suitable* for cutting tools which "can only be hardened by being uniformly heated and thereupon quenched as [an] entirety." Immediately following this passage, Strauss says, "For, in this case, tools of this type if made of common tool steel or of high speed

tool steel, would not only become glass-hardened at the cutting edges but in an objectionable manner all over." We construe this to mean simply that, *prior to Strauss's invention*, cutting tools made of high-speed tool steel would become glass-hardened all over if uniformly heated and quenched as an entirety, but that now, by virtue of the Strauss invention, the very desirable feature of uniform heating and quenching as an entirety in the manufacture of such cutting tools could be employed *without* resulting in a tool which is glass-hardened all over. This would be accomplished, according to Strauss, by starting with a material of low carbon content, carburizing a portion thereof, and heating and quenching the entire material.

[1] We therefore agree with the board that the Strauss process is not limited to the particular tool steel alloys specified in the patent (see first two paragraphs of Strauss disclosure quoted above), but "is a procedure generally applicable to any steel in which the hardenability is a function of the carbon content and is capable of selective carburization." It is axiomatic, we believe, that a patent is a good reference not only for what it discloses by way of direct anticipation but also for what it suggests to a person of ordinary skill in the art. In *re* Lundberg et al., 39 CCPA 971, 197 F.2d 336, 94 USPQ 73.

In summary, it is our view that, notwithstanding the fact that the particular materials used by Strauss might "be recognized as not having either the necessary fatigue resistance or red hardness for saw use," as appellants contend, it does not follow that Strauss leads away from the invention here on appeal. To the contrary, the Strauss disclosure as a whole is believed to direct one of ordinary skill in this art toward the manufacture of bandsaws having a tooth edge portion carburized to a high-speed tool steel carbon content and a backing zone homogeneous therewith in alloy content other than carbon.

In regard to the Gill publication, appellants call attention to the following passage which, they contend, was not given adequate consideration by the examiner and the board:

Carburization is never recommended for cutting tools such as drills, reamers and taps for the increased carbon content will include brittleness in the edges of these tools and result in early failure.

Our response to this contention is two-fold. First, the passage is taken out

of context, as indicated by noting even the next preceding sentence which says that "Carburization of high speed steel * * * may be advantageous where the resistance to abrasion is of great importance, as encountered in such tools as wearing plates and certain classes of blanking dies." The Gill publication is really directed to, and was used by the examiner for, a disclosure of the *properties* of alloys and the effect thereon of varying the content of certain elements, such as carbon; it is not directed to the *application* of these alloys to particular tools. However, insofar as certain cutting tools are mentioned, we believe one interested in producing bandsaws would not be directed away from the concept of carburizing a homogeneous strip low in carbon because Gill tells him that certain outstanding properties, which this person would be seeking, could be obtained thereby. Secondly, as aptly stated by the solicitor, the warnings mentioned in the above-quoted excerpt from Gill would serve to reinforce the Strauss suggestion that the alloy selected should have a reduced amount of carbon initially and that only the required amount of carbon be added in the portions *where needed*. Obviously, the entire tool cannot be free of a high carbon content. In short, the noted statements by Gill advising against using the usual high carbon tool steel alloy in certain types of tools could well lead toward, rather than away from, the use of a modified low carbon alloy in bandsaws.

For the reasons set forth above, the decision of the board is *affirmed*.

52 CCPA 962

Court of Customs and Patent Appeals

BOURNS, INC. v. INTERNATIONAL RESISTANCE COMPANY

Appl. No. 7268 Decided Feb. 11, 1965

TRADEMARKS

1. Evidence—Of use (§ 67.339)

Even though use of mark in interstate commerce is not proved by sales invoices and packing slips since they are not accompanied by testimony of someone familiar with transactions represented by such invoices and slips, averments that opposer uses trademark on goods similar to applicant's goods and that

registration of same mark to applicant would result in confusion damaging to opposer are supported by testimony of witness who identified photograph of goods, invoices, and packing list bearing mark and who testified that all goods shipped bore trademarks, that he had seen goods marked with involved mark, and inspection would not let goods be shipped without bearing mark set forth on sales invoices.

2. Opposition—Mark and use of opposer —In general (§ 67.5831)

It is not necessary under 15 U.S.C. 1063 for opposer to aver and prove use of mark in interstate commerce, since any person who believes that he would be damaged by registration of mark may oppose its registration.

Appeal from Trademark Trial and Appeal Board of the Patent Office; 138 USPQ 95.

Trademark opposition No. 41,096 by Bourns, Inc., against International Resistance Company, application, Serial No. 111,111 filed Dec. 30, 1960. From decision dismissing opposition, opposer appeals. Reversed.

OSCAR A. MELLIN and CARLISLE M. MOORE, both of San Francisco, Calif., and RAYMOND W. COLTON, Washington, D.C., for appellant.
DONALD S. COHEN, Philadelphia, Pa., for appellee.

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

SMITH, Judge.

At the outset it is to be noted that this appeal concerns a trademark opposition proceeding brought by appellant under the provisions of 15 U.S.C. 1063. The mark in issue is "CIRCUITRIM." Appellee avers use of the mark for variable resistors and seeks registration under its application serial No. 111,111 filed December 30, 1960.

The Trademark Trial and Appeal Board, 138 USPQ 95, in discussing the opposition stated:

The sole issue to be determined in this proceeding is that of priority of use and ownership, as between the parties, of the mark "CIRCUITRIM" for variable resistors, and more particularly potentiometers.

In commenting on the evidence before it, the board stated:

The evidence submitted by the parties on the issue here presented offers a contrast, that of applicant, consisting of the testimony of two offi-

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